

REMARKS

Applicants respectfully request entry of the following amendments and remarks contained herein in response to the Office Action mailed May 7, 2007. Applicants respectfully submit that the amendment and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1 – 2, 4, 7 – 8, 10 – 11, 13, 16, 18 – 20, 22 – 23, and 25 are pending. More specifically, Applicants amend claims 1 – 2, 4, 7 – 8, 10 – 11, 13, 16, 18 – 20, 22 – 23, and 25 and cancel claims 3, 5 – 6, 8, 19, 14 – 15, 17, 21, and 24 without prejudice, waiver, or disclaimer. Applicants cancel claims 3, 5 – 6, 8, 19, 14 – 15, 17, 21, and 24 merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Allowable Subject Matter

The Office Action indicates that claim 9 is allowable over the cited art, but is rejected under 35 U.S.C. §112. Applicants sincerely appreciate this indication of allowable subject matter. Additionally, as indicated above, Applicants amend claim 8 to incorporate the elements of claim 9 and remove the phrase “and combinations thereof.” Applicants respectfully submit that these amendments overcome the alleged 35 U.S.C. §112 issues and that claim 8, as amended, is allowable.

II. Examiner Interview

Applicants first wish to express their sincere appreciation for the time that Examiner Lai and Examiner Ho spent with Applicants' Attorney, Anthony Bonner, during a telephone discussion on July 17, 2007 regarding the outstanding Office Action. During that conversation, Examiner Lai, Examiner Ho, and Mr. Bonner discussed potential arguments and amendments with regard to claim 1, in view of *Appelman*. The general thrust of the potential principal arguments included a discussion of the allowability of claim 9. Thus, Applicants respectfully request that Examiner Lai carefully consider this response and the amendments.

III. Double Patenting

The Office Action indicates that claims 1 – 3 and 18 – 21 are provisionally rejected under the judicially created doctrine of nonstatutory double patenting as being allegedly unpatentable over claims 1, 3, 6, and 9 – 10 of copending Application Number 10/686,431. Applicants agree to file a terminal disclaimer, if necessary, at the time of allowance.

IV. Rejections Under 35 U.S.C. §101

The Office Action indicates that claims 10 – 17 stand rejected under 35 U.S.C. §101 as alleging that the invention is directed to non-statutory subject matter. Applicants amend claims 10 – 11, 13, and 16 and cancel claims 9, 12, and 14 – 15, as indicated above. Applicants submit that these amendments comply with the Office Action request and that claims 10 – 11, 13, and 16 are allowable in view of 35 U.S.C. §101.

V. Rejections Under 35 U.S.C. §112

The Office Action indicates that claim 9 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants amend claim 8 and cancel claim 9,

as indicated above. Applicants submit that these amendments comply with the Office Action request and that claim 8, as amended, is allowable.

VI. Rejections Under 35 U.S.C. §102

A. Claim 1 is Allowable Over Appelman

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,912,564 (“*Appelman*”). Applicants respectfully traverse this rejection on the grounds that *Appelman* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 1 recites:

A method for handling digital messages, the method comprising:
determining whether a sender of a received email message is currently present at an Instant Messaging (IM) account; and
in response to determining that the sender of the received email message is currently present at an IM account, ***automatically launching an IM session with the sender.***
(emphasis added)

Applicants respectfully submit that claim 1, as amended, is allowable over the cited art for at least the reason that *Appelman* fails to disclose, teach, or suggest a “method for handling digital messages, the method comprising... in response to determining that the sender of the received email message is currently present at an IM account, ***automatically launching an IM session with the sender***” as recited in claim 1, as amended. More specifically, *Appelman* discloses “by clicking on the person’s address, the recipient may send an e-mail message to the person” (column 14, line 30 and FIG. 10). Applicants respectfully submit that this is different than the elements of claim 1 for at least the reason that clicking on an address to send an email is different than automatically launching an IM session with a sender. For at least this reason, claim 1, as amended, is allowable.

B. Claim 8 is Allowable Over Appelman

The Office Action indicates that claim 8 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,912,564 (“*Appelman*”). Applicants respectfully traverse this rejection on the grounds that *Appelman* does not disclose, teach, or suggest all of the claimed elements. More specifically, as indicated above, Applicants amend claim 8 by including the elements of allowable claim 9. Applicants respectfully submit that claim 8, as amended, is allowable.

C. Claim 10 is Allowable Over Appelman

The Office Action indicates that claim 10 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,912,564 (“*Appelman*”). Applicants respectfully traverse this rejection on the grounds that *Appelman* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 10 recites:

A computer-readable storage medium comprising:
computer-readable code adapted to instruct a programmable device to determine whether a sender of a received email message is currently present at an Instant Messaging (IM) account; and
computer-readable code adapted to instruct a programmable device to, in response to determining that the sender of the received email message is currently present at an IM account, ***automatically launch an IM session with the sender.***

(emphasis added)

Applicants respectfully submit that claim 10, as amended, is allowable over the cited art for at least the reason that *Appelman* fails to disclose, teach, or suggest a “computer-readable storage medium comprising... computer-readable code adapted to instruct a programmable device to, in response to determining that the sender of the received email message is currently present at an IM account, ***automatically launch an IM session with the sender***” as recited in claim 10, as amended. More specifically, *Appelman* discloses “by clicking on the person’s

address, the recipient may send an e-mail message to the person" (column 14, line 30 and FIG. 10). Applicants respectfully submit that this is different than the elements of claim 10 for at least the reason that clicking on an address to send an email is different than automatically launching an IM session with a sender. For at least this reason, claim 10, as amended, is allowable.

D. Claim 18 is Allowable Over Appelman

The Office Action indicates that claim 18 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,912,564 ("Appelman"). Applicants respectfully traverse this rejection on the grounds that *Appelman* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 18 recites:

A system for handling digital messages, the system comprising:
means for determining whether a sender of a received email message is currently present at an Instant Messaging (IM) account; and
means for, in response to determining that the sender of the received email message is currently present at an IM account,
automatically launching an IM session with the sender.
(emphasis added)

Applicants respectfully submit that claim 18, as amended, is allowable over the cited art for at least the reason that *Appelman* fails to disclose, teach, or suggest a "system for handling digital messages, the system comprising... means for, in response to determining that the sender of the received email message is currently present at an IM account, ***automatically launching an IM session with the sender***" as recited in claim 18, as amended. More specifically, *Appelman* discloses "by clicking on the person's address, the recipient may send an e-mail message to the person" (column 14, line 30 and FIG. 10). Applicants respectfully submit that this is different than the elements of claim 18 for at least the reason that clicking on an address to send an email is different than automatically launching an IM session with a sender. For at least this reason, claim 18, as amended, is allowable.

E. Claim 19 is Allowable Over Appelman

The Office Action indicates that claim 19 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,912,564 (“*Appelman*”). Applicants respectfully traverse this rejection on the grounds that *Appelman* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 19 recites:

A system for handling digital messages, the system comprising:
condition-determination logic adapted to determine whether a sender of a received email message is currently present at an Instant Messaging (IM) account; and
launch logic configured to, in response to determining that the sender of the email message is currently present at an IM account, ***automatically launch an IM session with the sender.***
(emphasis added)

Applicants respectfully submit that claim 19, as amended, is allowable over the cited art for at least the reason that *Appelman* fails to disclose, teach, or suggest a “system for handling digital messages, the system comprising... launch logic configured to, in response to determining that the sender of the email message is currently present at an IM account, ***automatically launch an IM session with the sender***” as recited in claim 19, as amended. More specifically, *Appelman* discloses “by clicking on the person’s address, the recipient may send an e-mail message to the person” (column 14, line 30 and FIG. 10). Applicants respectfully submit that this is different than the elements of claim 19 for at least the reason that clicking on an address to send an email is different than automatically launching an IM session with a sender. For at least this reason, claim 19, as amended, is allowable.

F. Claim 25 is Allowable Over Appelman

The Office Action indicates that claim 25 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,912,564 (“*Appelman*”). Applicants respectfully traverse this rejection on the grounds that *Appelman* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 25 recites:

A system for handling digital messages, the system comprising:
condition-determination logic adapted to determine whether a
sender of a received digital message is currently present at an Instant
Messaging (IM) account;
launch logic configured to, in response to determining that the
sender of the received digital message is currently present at an IM
account, ***automatically launch an IM session with the sender.***
(emphasis added)

Applicants respectfully submit that claim 25, as amended, is allowable over the cited art for at least the reason that *Appelman* fails to disclose, teach, or suggest a “system for handling digital messages, the system comprising... launch logic configured to, in response to determining that the sender of the received digital message is currently present at an IM account, ***automatically launch an IM session with the sender***” as recited in claim 25, as amended. More specifically, *Appelman* discloses “by clicking on the person’s address, the recipient may send an e-mail message to the person” (column 14, line 30 and FIG. 10).
Applicants respectfully submit that this is different than the elements of claim 25 for at least the reason that clicking on an address to send an email is different than automatically launching an IM session with a sender. For at least this reason, claim 25, as amended, is allowable.

G. Claims 2, 11, 16, and 20 are Allowable Over Appelman

The Office Action indicates that claims 2, 11, 16, and 20 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,912,564 (“*Appelman*”).
Applicants respectfully traverse this rejection on the grounds that *Appelman* does not disclose, teach, or suggest all of the claimed elements. More specifically, dependent claim 2 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 1.
1. Dependent claim 11 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 10. Dependent claim 16 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 13. Further, dependent claim 20 is believed to be allowable for at least the reason that this claim depends

from allowable independent claim 19. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

VII. Rejections Under 35 U.S.C. §103

A. Claim 4 is Allowable Over Thurlow in view of Monday

The Office Action indicates that claim 4 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,057,841 ("Thurlow") in view of U.S. Patent Number 6,480,860 ("Monday"). Applicants respectfully traverse this rejection for at least the reason that *Thurlow* in view of *Monday* fails to disclose, teach, or suggest all of the elements of claim 4. More specifically, claim 4 recites:

A method for handling digital messages, the method comprising:
 providing a programming interface, the programming interface adapted to receive user input, the user input being provided in a markup language;
 storing inputs provided by a user at the programming interface, the inputs being provided in the markup language, the inputs comprising a condition, the inputs further comprising an action;
 receiving a digital message from a message sender;
 determining whether the digital message includes a request for a file; and
 retrieving the requested file.

(emphasis added)

Applicants respectfully submit that claim 4, as amended, is allowable over the cited art for at least the reason that the cited art fails to disclose, teach, or suggest a "method for handling digital messages, the method comprising... receiving a digital message from a message sender... [and] **determining whether the digital message includes a request for a file**" as recited in claim 4, as amended. More specifically, *Thurlow* discloses "creating and editing rules for processing electronic messages" (column 2, line 6). Applicants respectfully submit that this is different than the elements of claim 4 for at least the reason that creating and editing rules for processing received messages is different than determining whether a digital

message includes a request for a file. For at least this reason, claim 4, as amended, is allowable over the cited art.

Additionally, *Monday* fails to overcome the deficiencies of *Thurlow*. More specifically, *Monday* discloses “defin[ing] a markup language for accessing data in extensible markup language (XML) by creating suitable document type definitions (DTDs), which define grammar for accessing data in the database using the markup language” (column 1, line 50). For at least the reason that defining a markup language is different than determining whether a digital message includes a request for a file, claim 4, as amended, is allowable.

B. Claim 13 is Allowable Over *Thurlow* in view of *Monday*

The Office Action indicates that claim 13 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,057,841 (“*Thurlow*”) in view of U.S. Patent Number 6,480,860 (“*Monday*”). Applicants respectfully traverse this rejection for at least the reason that *Thurlow* in view of *Monday* fails to disclose, teach, or suggest all of the elements of claim 13. More specifically, claim 13 recites:

A computer-readable storage medium comprising:
computer-readable code representing a condition, the condition being in a markup language;
computer-readable code representing an action, the action being in a markup language;
computer-readable code adapted to instruct a programmable device to receive a digital message from a message sender;
computer-readable code adapted to instruct a programmable device to determine whether the digital message meets the condition; and
computer-readable code adapted to instruct a programmable device to retrieve the requested file.

(emphasis added)

Applicants respectfully submit that claim 13, as amended, is allowable over the cited art for at least the reason that the cited art fails to disclose, teach, or suggest a “computer-readable storage medium comprising... computer-readable code adapted to instruct a programmable

device to receive a digital message from a message sender... [and] ***computer-readable code adapted to instruct a programmable device to determine whether the digital message meets the condition***" as recited in claim 13, as amended. More specifically, *Thurlow* discloses "creating and editing rules for processing electronic messages" (column 2, line 6). Applicants respectfully submit that this is different than the elements of claim 13 for at least the reason that creating and editing rules for processing received messages is different than determining whether a digital message includes a request for a file. For at least this reason, claim 13, as amended, is allowable over the cited art.

Additionally, *Monday* fails to overcome the deficiencies of *Thurlow*. More specifically, *Monday* discloses "defin[ing] a markup language for accessing data in extensible markup language (XML) by creating suitable document type definitions (DTDs), which define grammar for accessing data in the database using the markup language" (column 1, line 50). For at least the reason that defining a markup language is different than determining whether a digital message includes a request for a file, claim 13, as amended, is allowable.

C. **Claim 22 is Allowable Over *Thurlow* in view of *Monday***

The Office Action indicates that claim 22 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,057,841 ("*Thurlow*") in view of U.S. Patent Number 6,480,860 ("*Monday*"). Applicants respectfully traverse this rejection for at least the reason that *Thurlow* in view of *Monday* fails to disclose, teach, or suggest all of the elements of claim 22. More specifically, claim 22 recites:

A system for handling digital messages, the system comprising:
program-interface logic configured to provide a programming interface, the programming interface adapted to receive user input, the user input being provided in a markup language; and
input-storage logic configured to store inputs provided by a user at the programming interface, the inputs being provided in the markup language, the inputs comprising a condition, the inputs further comprising an action;
receiving logic configured to receive a digital message from a

message sender;
determining logic configured to determine whether the digital message includes a request for a file; and
retrieving logic configured to retrieve the requested file.
(emphasis added)

Applicants respectfully submit that claim 22, as amended, is allowable over the cited art for at least the reason that the cited art fails to disclose, teach, or suggest a “system for handling digital messages, the system comprising... receiving logic configured to receive a digital message from a message sender... [and] ***determining logic configured to determine whether the digital message includes a request for a file***” as recited in claim 22, as amended. More specifically, *Thurlow* discloses “creating and editing rules for processing electronic messages” (column 2, line 6). Applicants respectfully submit that this is different than the elements of claim 22 for at least the reason that creating and editing rules for processing received messages is different than determining whether a digital message includes a request for a file. For at least this reason, claim 22, as amended, is allowable over the cited art.

Additionally, *Monday* fails to overcome the deficiencies of *Thurlow*. More specifically, *Monday* discloses “defin[ing] a markup language for accessing data in extensible markup language (XML) by creating suitable document type definitions (DTDs), which define grammar for accessing data in the database using the markup language” (column 1, line 50). For at least the reason that defining a markup language is different than determining whether a digital message includes a request for a file, claim 22, as amended, is allowable.

D. **Claim 23 is Allowable Over Thurlow in view of Monday**

The Office Action indicates that claim 23 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,057,841 (“*Thurlow*”) in view of U.S. Patent Number 6,480,860 (“*Monday*”). Applicants respectfully traverse this rejection for at least the reason that *Thurlow* in view of *Monday* fails to disclose, teach, or suggest all of the elements of claim 23. More specifically, claim 23 recites:

A system for handling digital messages, the system comprising:

- means for providing a programming interface, the programming interface adapted to receive user input, the user input being provided in a markup language; and
- means for storing inputs provided by a user at the programming interface, the inputs being provided in the markup language, the inputs comprising a condition, the inputs further comprising an action;
- means for receiving a digital message from a message sender;
- means for determining whether the digital message includes a request for a file;** and
- means for retrieving the requested file.

(emphasis added)

Applicants respectfully submit that claim 23, as amended, is allowable over the cited art for at least the reason that the cited art fails to disclose, teach, or suggest a “system for handling digital messages, the system comprising... means for receiving a digital message from a message sender... [and] **means for determining whether the digital message includes a request for a file**” as recited in claim 23, as amended. More specifically, *Thurlow* discloses “creating and editing rules for processing electronic messages” (column 2, line 6). Applicants respectfully submit that this is different than the elements of claim 23 for at least the reason that creating and editing rules for processing received messages is different than determining whether a digital message includes a request for a file. For at least this reason, claim 23, as amended, is allowable over the cited art.

Additionally, *Monday* fails to overcome the deficiencies of *Thurlow*. More specifically, *Monday* discloses “defin[ing] a markup language for accessing data in extensible markup language (XML) by creating suitable document type definitions (DTDs), which define grammar for accessing data in the database using the markup language” (column 1, line 50). For at least the reason that defining a markup language is different than determining whether a digital message includes a request for a file, claim 23, as amended, is allowable.

E. Claim 7 is Allowable Over Thurlow in view of Monday further in view of Appelman

The Office Action indicates that claim 7 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Number 6,057,841 (“*Thurlow*”) in view of U.S. Patent Number 6,480,860 (“*Monday*”), further in view of U.S. Patent Number 6,912,564 (“*Appelman*”). Applicants respectfully traverse this rejection for at least the reason that *Thurlow* in view of *Monday* further in view of *Appelman* fails to disclose, teach, or suggest all of the elements of claim 7. More specifically, dependent claim 7 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 4. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/afb/

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